

Attorney Docket: 00059
U.S. Application No.: 09/751,288 Examiner: Shang Art Unit: 2623
Response to October 4, 2007 Office Action

REMARKS

In response to the Office Action dated October 4, 2007, the Assignee respectfully requests reconsideration based on the above amendments and on the following remarks.

Claims 9-15 and 20-28 are pending in this application. Claims 1-8 and 16-19 were previously canceled without prejudice or disclaimer.

Rejection of Claims Under § 102 (e)

The Office rejects claims 20-25 under 35 U.S.C. § 102 (e) as being anticipated by U.S. Patent 6,104,337 to Allport. A claim, however, is anticipated only if each and every element is found in a single prior art reference. *See Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q. 2d (BNA) 1051, 1053 (Fed. Cir. 1987). *See also* DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2131 (orig. 8th Edition) (hereinafter "M.P.E.P.").

Claims 20-25, however, are not anticipated by *Allport*. These claims recite, or incorporate, features that are not disclosed or suggested by *Allport*. Independent claim 23, for example, recites "*a remote control receiver in communication with the processor, the remote control receiver receiving data from an electronic program guide, the data indicating an occurrence of a scheduled event*" (emphasis added). Independent claim 23 also recites "*wherein after the processor receives said data from the remote control receiver, the processor retrieves instructions from the data storage area, interprets said data based upon said retrieved instructions and controls said output device to produce a customized alert associated with said scheduled event*." For the Examiner's convenience, independent claim 23 is reproduced below.

23. A remote control device, comprising:

a processor;

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a remote control receiver in communication with the processor, the remote control receiver receiving data from an electronic program guide, the data indicating an occurrence of a scheduled event;

an input device in communication with the processor;

a data storage area in communication with the processor; and

an output device in communication with the processor,

wherein after the processor receives said data from the remote control receiver, the processor retrieves instructions from the data storage area, interprets said data based upon said retrieved instructions and controls said output device to produce a customized alert associated with said scheduled event.

Allport cannot anticipate these features. *Allport* is entirely silent to a “receiving data from an electronic program guide, the data indicating an occurrence of a scheduled event” (emphasis added). *Allport* makes absolutely no teaching or suggestion of these features. *Allport*, in fact, completely fails to even mention “an electronic program guide,” and any data from an EPG that indicates “an occurrence of a scheduled event.” The Office cites to various passages of *Allport*, but the Office is, very respectfully, mistaken. The Office, for example, cites to column 10, lines 27-38 of *Allport*. This passage discusses an “updates screen” that allows a consumer-user to load TV schedules into the memory of the remote control. U.S. Patent 6,104,337 to *Allport* at column 10, lines 31-35. This passage is entirely silent to “receiving data from an electronic program guide, the data indicating an occurrence of a scheduled event.”

The Office also cites to column 13, line 19 through column 14, line 25 of *Allport*. These passages discuss a “list alternatives” screen in which the consumer-user may enable, or disable, updates to the remote control. *See id.* at column 13, lines 32-33. *Allport* explains that this “list alternatives” screen shows program listings and a source for each program (e.g., broadcast, cable, satellite, or VCR). *See id.* at column 13, lines 47-65. The consumer-user may “touch” a program listing to add or remove the program to a “favorites” listing. *See id.* at column 14, lines 7-17. A slider control may be used to select sources for programs or to adjust a volume. *See id.* at column 14, lines 17-25. These passages, then, are entirely silent to “receiving data from an electronic program guide, the data indicating an occurrence of a scheduled event.”

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The Office also cites to column 18, lines 23-38 of *Allport*. Here *Allport* discusses a "browse favorite alternatives" screen. U.S. Patent 6,104,337 to Allport at column 18, lines 23-26. This screen has different configurations, depending on whether updates are enabled or disabled. *See id.* at column 18, lines 27-38. Again, then, these passages are entirely silent to *"receiving data from an electronic program guide, the data indicating an occurrence of a scheduled event."*

Now, the Office is directed to column 10, lines 18-26. These lines discuss a "scheduler screen" that "allows the consumer to monitor and control ... future tasks scheduled to be performed by the devices." *See id.* at column 10, lines 20-23. In later passages *Allport* explains that this "scheduler screen" allows the user to establish programming filters. *See id.* at column 21, lines 10-11. *Allport* also explains that a parent may establish a "time budget" for a user, thus limiting the amount of time that a child may watch TV. *See id.* at column 21, lines 19-21. The "scheduler screen" may also be used to review IR commands issued by the remote. *See id.* at column 21, lines 35-40. Again, then, these passages are entirely silent to *"receiving data from an electronic program guide, the data indicating an occurrence of a scheduled event."*

Moreover, *Allport's* recording procedure is unlike independent claim 23. When a user wants to record a program, the user selects the program from the display. *See* U.S. Patent 6,104,337 to Allport at column 15, lines 31-34. If the time to record coincides with the current time, the remote control sends "the appropriate IR commands ... to the associated device ... for recording the selected program." *See id.* at column 15, lines 34-38. **"If, however, the time to record is in the future, the remote control programs itself to send the appropriate IR commands at the required time."** *Id.* at column 15, lines 38-40 (emphasis added). **"The remote control has an integrated real time clock for this sort of timing."** *Id.* at column 15, lines 40-41 (emphasis added).

Allport, then, operates unlike independent claim 23. Independent claim 23 recites *"a remote control receiver in communication with the processor, the remote control receiver*

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receiving data from an electronic program guide, the data indicating an occurrence of a scheduled event" (emphasis added). The patent to Allport, in contradistinction, describes a remote control that uses an internal clock to recognize the occurrence of a scheduled event. Allport, then, does not teach or suggest "receiving data from an electronic program guide, the data indicating an occurrence of a scheduled event."

Claims 20-25, then, are not anticipated by Allport. Independent claim 23 recites many features that are not taught or suggested by Allport. The dependent claims incorporate these same features and recite additional features. Claims 20-25, then, cannot be anticipated, so the Office is respectfully requested to remove the § 102 (e) rejection of these claims.

Allport "Teaches Away"

The Office also rejected claims 9-15 and 26-28 under 35 U.S.C. § 103 (a) as being obvious over Allport in view of U.S. Patent 6,346,891 to Feinlab, *et al.*

Claims 9-15 and 26-28, however, are not obvious over any combination involving Allport. As the following paragraphs explain, Allport "teaches away" from the pending claims and, thus, cannot support a *prima facie* case for obviousness. "A reference that 'teaches away' from the claimed invention is a significant factor" when determining obviousness. See M.P.E.P. at § 2145 (X)(D)(1). A reference must be considered as a whole, including portions that lead away from the claimed invention. See *id.* at § 2141.02; see also *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 220 U.S.P.Q. (BNA) 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). "It is improper to combine references where the references teach away from their combination." M.P.E.P. at § 2145 (X)(D)(2). If the proposed combination changes the principle of operation of the prior art being modified, then the teachings of the references are not sufficient to support a *prima facie* case. See M.P.E.P. at § 2143.01.

The Examiner's *prima facie* case requires an impermissible change to Allport's principle of operation. As the above paragraphs explained, Allport's principle of operation uses an

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internal clock to recognize the occurrence of a scheduled event. If the time to record coincides with the current time, the remote control sends "the appropriate IR commands ... to the associated device ... for recording the selected program." U.S. Patent 6,104,337 to Allport at column 15, lines 34-38. **"If, however, the time to record is in the future, the remote control programs itself to send the appropriate IR commands at the required time."** *Id.* at column 15, lines 38-40 (emphasis added). **"The remote control has an integrated real time clock for this sort of timing."** *Id.* at column 15, lines 40-41 (emphasis added).

Allport's principle of operation, therefore, must be changed to obviate claims 9-15 and 26-28. *Allport's* principle of operation must be changed to include "a transmitter in communication with the electronic program guide, the transmitter transmitting data from the electronic program guide to the remote control device, the data indicating an occurrence of the scheduled event," as independent claims 26 and 28 similarly recite (emphasis added). The patent laws, however, forbid changing a principle of operation to support a *prima facie* case. Any proposed combination involving *Allport*, then, "teaches away" and cannot support a *prima facie* case for obviousness. The Office is thus respectfully requested to remove the § 103 rejection of claims 9-15 and 26-28.

If any issues remain outstanding, the Office is requested to contact the undersigned at (919) 469-2629 or scott@scottzimmerman.com.

Respectfully submitted,



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